

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN B. RIEGER
and
JAMES A. FRIDAY

Appeal No. 1996-2801
Application 08/134,361

ON BRIEF

Before KIMLIN, GARRIS and SPIEGEL, ***Administrative Patent
Judges.***

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GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3, 4, and 6 through 21, which are all of the claims pending in the application.

The subject matter on appeal relates to a multilayered color photographic element comprising at least two blue sensitive silver halide emulsion layers of different sensitivities wherein the more sensitive blue layer is farther from the element support and wherein the weight ratio of dye-forming coupler to photo-graphic silver halide (expressed as silver) in this more sensitive layer is not more than 0.10. This appealed subject matter is adequately illustrated by independent claim 1, which reads as follows:

1. A multilayered color photographic element comprising a support having coated thereon photographic silver halide emulsion layers said layers including at least two blue sensitive silver halide emulsion layers of different

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sensitivities, the blue sensitive layers being the emulsion layers farthest from the support, wherein

the first of said blue sensitive layers is the most sensitive blue layer and is the emulsion layer farthest from the support, wherein the weight ratio of dye-forming coupler to photographic silver halide (expressed as silver) in the first blue sensitive layer is not more than 0.10, the second blue sensitive layer being contiguous said first blue sensitive layer and containing an acylacetamide yellow dye-forming coupler.

The references set forth below are relied upon by the

examiner in the rejections before us:

Chari et al. (Chari)	5,190,851	Mar. 2, 1993
Chang et al. (Chang)	EP 432,834	June 19, 1991
(European Patent Application)		

Claims 7 and 19 through 21 are rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention. According to the examiner,

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[e]ach of claims 7 and 19-21 fail to particularly point out and distinctly claim how "substantially free" of yellow dye-forming coupler is within the scope of the weight ratio of dye-forming coupler to photographic silver in the blue sensitive layer of not more than 0.10 (answer, page 7).

Claims 8 through 11 and 13 through 16

are each rejected under 35 U.S.C. § 112, first paragraph, when they each recite "wherein the weight ratio of dye-forming coupler to photographic silver halide (expressed as silver) in the first blue sensitive layer is not more than 0.10", for the reasons set forth in the objection to the specification (answer, page 6).

Claims "1-7 [sic, 1, 3, 4, 6, 7] and 11 are rejected under 35 U.S.C. § 102(e) as being anticipated by Chari" (answer, page 3).

Claims 10, 12 through 17, and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Chari.

Finally, claims 8, 9, 18, 19 and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over Chari in view of Chang.

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We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejections.

We cannot sustain any of the rejections advanced by the examiner in this appeal.

On page 6 of the brief, the appellants have responded to the examiner's aforequoted criticism under the second paragraph of § 112 concerning "how "substantially free" . . . is within the scope of the weight ratio . . . of not more than 0.10." This response, in our view, fully and satisfactorily resolves the § 112, second paragraph, criticism raised by the examiner. Although the examiner has clearly maintained the rejection under consideration (e.g., see the last paragraph on page 10 of the answer), she has given utterly no reason for being unpersuaded by the appellants' earlier-mentioned arguments on page 6 of the brief.

Under these circumstances, it is apparent that we cannot sustain the examiner's § 112, second paragraph, rejection of claims 7 and 19 through 21.

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Concerning the § 112, first paragraph, rejection which plainly relates to the written description requirement, the examiner's position has no perceptible merit. In addition to the comments made by the appellants, we point out that the claim recitation referred to by the examiner unquestionably satisfies the written description requirement as evinced, for example, by original claim 2. It follows that we also cannot sustain the examiner's § 112, first paragraph, rejection of claims 8 through 11 and 13 through 16.

As correctly argued by the appellants, each of the examiner's prior art rejections is improper because the Chari reference contains no teaching or suggestion of the weight ratio required by all of the claims on appeal. Significantly, the examiner has not explicitly disagreed with the appellants on this matter and, indeed, has not explicitly addressed the here-claimed ratio in her answer. Under these circumstances, we cannot sustain the examiner's § 102 rejection of claims 1, 3, 4, 6, 7 and 11 over Chari, or her § 103 rejection of claims 10, 12

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through 17, and 20 over Chari, or her § 103 rejection of
claims 8, 9, 18, 19 and 21 over Chari in view of Chang.

The decision of the examiner is reversed.

REVERSED

	EDWARD C. KIMLIN)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	BRADLEY R. GARRIS)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
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)	
	CAROL A. SPIEGEL)	
	Administrative Patent Judge)	

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BRG:psb

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